

AMENDMENTS TO THE DRAWINGS

Fig. 9 has been amended in response to the Examiner's objection to the drawings imposed in the fourth enumerated paragraph on page 2 of the August 9, 2006 Office Action, as indicated in the (Replacement Sheet) submitted herewith (Exhibit A).

REMARKS

Claims 1, 2, 4, 6 through 10 and 12 through 30 are pending in this Application, of which claims 12 through 29 stand withdrawn from consideration pursuant to the provisions of 37 C.F.R. § 1.142(b). Accordingly, claims 1, 2, 4, 6 through 10 and 30 are active.

Fig. 9, the Abstract of the Disclosure, and the specification have been amended to address formalities. In addition, claims 1, 4, 8 and 10 have been amended and claims 3, 5, and 11 have been canceled. Care has been exercised to avoid the introduction of new matter. Adequate descriptive support for the present Amendment should be apparent throughout the originally filed disclosure, noting that the limitations of claim 3 have been incorporated into claim 1, and similar limitations have been incorporated into claim 4, claims 1 and 4 being the only independent claims. Applicants submit that the present Amendment does not generate any new matter issue.

Drawing Objection.

The Examiner objected to the drawings pursuant to 37 C.F.R. § 1.83(a). Applicants have submitted herewith an amended Fig. 9 (Replacement Sheet, Exhibit A) addressing the issue raised by the Examiner. In addition, the specification has also been amended to reflect that the step or incline in the channel is formed such that a depth from the undersurface 145a of the SUS plate 45 to the bottom face 117a is equal to a depth of ("a") of the fuel channels 105.

Applicants, therefore, solicit withdrawal of the drawing objection.

Objections to the Disclosure.

The Examiner objected to the Abstract of the Disclosure asserting a grammatical informality, which is addressed by the present Amendment.

The Examiner also objected to the specification, noting page 25, line 24, where Fig. 1 is recited; whereas, Figs. 1A-1B are present. In addition, the Examiner asserted that the specification should be reviewed for similar informalities. The present Amendment addresses this issue and corrects the informalities in designating the appropriate figures.

Applicants, therefore, solicit withdrawal of the objection to the specification.

Claims 3, 4, and 9 through 11 were rejected under the second paragraph of 35 U.S.C. § 112.

In the statement of the rejection the Examiner pointed to terminology perceived to render the claims indefinite. This rejection is traversed.

In response the claims have been amended to address each issue raised by the Examiner, thereby overcoming the stated bases for the imposed rejection. Applicants submit that one having ordinary skill in the art would have no difficulty understanding the scope of the claimed invention, particularly when reasonably interpreted in light of and consistent with the written description of the specification, which is the judicial standard. *Miles Laboratories, Inc. v. Shandon, Inc.*, 997 F.2d 870, 27 USPQ2d 1123 (Fed. Cir. 1993).

Applicants, therefore, submit that the imposed rejection of claims 3, 4 and 9 through 11 under the second paragraph of 35 U.S.C. § 112 is not viable and, hence, solicit withdrawal thereof.

Claims 1 through 5, 8, 9, and 30 were rejected under 35 U.S.C. § 102 for lack of novelty as evidenced by JP 2001-043868A (JP '868).

In the statement of rejection the Examiner asserted that JP '868 discloses a fuel cell separator corresponding to that claimed, referring to Figs. 1 and 4 through 6. This rejection is traversed.

The factual determination of lack of novelty under 35 U.S.C. § 102 requires the identical disclosure in a single reference of each element of a claimed invention, such that the identically claimed invention is placed into the recognized possession of one having ordinary skill in the art. *Dayco Prods., Inc. v. Total Containment, Inc.*, 329 F.3d 1358, 66 USPQ2d 1801 (Fed. Cir. 2003); *Crown Operations International Ltd. v. Solutia Inc.*, 289 F.3d 1367, 62 USPQ2d 1917 (Fed. Cir. 2002). There is a fundamental difference between the claimed fuel cell separator and the fuel cell separator disclosed by JP '868 that scotches the factual determination that JP '868 discloses a fuel cell separator identically corresponding to that claimed.

Specifically, the fuel cell separator defined in independent claim 1 comprises, *inter alia*, a cover plate covering the upper surface of the feeding manifold such that a distance between the undersurface of the cover plate and the bottom face of the feeding manifold is substantially equal to the depth of the channels. The fuel cell separator defined in claim 4 comprises, *inter alia*, cover plates covering the upper surfaces of the feeding and the discharge manifolds, where the cover plates are made of different materials for the feeding and the discharge manifolds. No such fuel cell separators are disclosed or suggested by JP '868.

In rejecting the claims under 35 U.S.C. § 102, in the second full paragraph on page 6 of the August 9, 2006 Office Action, the Examiner asserted that in the fuel cell separator of JP '868:

The electrode adjacent to the open side of the separator can be construed as a cover plate which then covers the upper surface of the feeding manifold.

Applicants disagree. Indeed, advertent to Fig. 1 of JP '868, it should be apparent that the feeding manifold corresponds to the component part indicated by the reference symbol "5". As shown in Fig. 1, there is no cover plate which covers the component part indicated by the reference symbol "5". Therefore, JP '868 neither discloses nor suggests a fuel cell separator with a cover plate as set forth in independent claims 1 and 4.

Applicants point out that the above argued difference between the claimed inventions and JP '868 is functionally significant. This is because by covering the upper surface of a part of the feeding manifold with a cover plate, when stacking with a catalyst electrode-solid polymer electrode membrane composite to form a fuel cell stack, the surface of the separator sandwiching the catalyst electrode-solid polymer electrode membrane composite becomes flat, thereby resulting in stable production of a fuel cell stack and improved yield. Moreover, as set forth in claim 1, the distance between the undersurface of the cover plate and the bottom face of the feeding manifold is substantially equal to the depth of the channels, thereby enhancing smooth feeding of fuel gas. Further, as to independent claim 4, the cover plates are made of different materials, thereby ensuring excellent fuel cell properties while reducing production costs. This is because a highly corrosion-resistant cover plate can be used for the upper part of the feeding manifold while a substantially corrosion-resistant cover plate can be used for the upper part of the discharge manifold.

The above argued functionally significant structural differences between the claimed inventions and the fuel cell separator disclosed by JP '868 undermine the factual determination that JP '868 discloses a fuel cell separator identically corresponding to those claimed. *Minnesota Mining & Manufacturing Co. v. Johnson & Johnson Orthopaedics Inc.*, 976 F.2d 1559, 24

USPQ2d 1321 (Fed. Cir. 1992); Kloster Speedsteel AB v. Crucible Inc., 793 F.2d 1565, 230 USPQ 81 (Fed. Cir. 1986). Applicants, therefore, submit that the imposed rejection of claims 1 through 5, 8, 9 and 30 under 35 U.S.C. § 102 for lack of novelty as evidenced by JP '868 is not factually viable and, hence, solicit withdrawal thereof.

Claim 6 was rejected under 35 U.S.C. § 103 for obviousness predicated upon JP '868 in view of Krasij.

Claim 7 was rejected under 35 U.S.C. § 103 for obviousness predicated upon JP '868 in view of Kneidel.

Claims 10 and 11 were rejected under 35 U.S.C. § 103 for obviousness predicated upon JP '868 in view of Tsien, Bjaareklint or Okamoto.

Each of the above rejections under 35 U.S.C. § 103 is traversed. Specifically, claims 6, 7 and 10 (claim 11 having been canceled) depend from independent claim 1. Applicants incorporate herein the arguments previously advanced in traversing the imposed rejection of claim 1 under 35 U.S.C. § 102 for lack of novelty as evidenced by JP '868. The secondary references to Krasij, Kneidel, Tsien, Bjaareklint, and Okamoto do not cure the previously argued deficiencies of JP '868. Accordingly, even if the references are combined as proposed by the Examiner, and Applicants do not agree that the requisite fact-based motivation has been established, the claimed inventions would not result. *Uniroyal, Inc. v. Rudkin-Wiley Corp., 837 F.2d 1044, 5 USPQ2d 1434 (Fed. Cir. 1988)*.

Applicants, therefore, submit that the imposed rejection of claim 6 under 35 U.S.C. § 103 for obviousness predicated upon JP '868 in view of Krasij; the imposed rejection of claim 7 under 35 U.S.C. § 103 for obviousness predicated upon JP '868 in view of Kneidel; and the

imposed rejection of claims 10 and 11 under 35 U.S.C. § 103 for obviousness predicated upon JP '868 in view of Tsien, Bjaareklint or Okamoto are not factually or legally viable and, hence, solicit withdrawal thereof.

Based upon the foregoing it should be apparent that the imposed objections and rejections have been overcome, and that all active claims are in condition for immediate allowance. Favorable consideration is, therefore, solicited.

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 500417 and please credit any excess fees to such deposit account.

Respectfully submitted,

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